



Serial No. 09/985,767

Docket No.: 1293.1242

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Chong-sam CHUNG et al.

Serial No. 09/985,767

Group Art Unit: 2653

Confirmation No. 4419

Filed: November 6, 2001

Examiner: Paul W. Huber

For: OPTICAL PICKUP FOR DETECTING THICKNESS VARIATION OF A RECORDING MEDIUM, AND/OR COMPENSATION FOR SPHERICAL ABERRATION CAUSED BY THICKNESS VARIATION OF A RECORDING MEDIUM

RESPONSE TO RESTRICTION REQUIREMENT

RECEIVED

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

AUG 24 2004

Technology Center 2600

Sir:

This is responsive to the Office Action mailed July 20, 2004, having a shortened period for response set to expire on August 20, 2004, the following remarks are respectfully provided.

I. Provisional Election of Claims Pursuant to 37 CFR §1.142

Applicants provisionally elect **Species I**, which is drawn to the optical pickup illustrated in FIGS. 5 and 8 in response to the preliminary restriction requirement set forth in the Office Action. As such, applicants elect claims 1, 2, 7, 8, 10, 12-16, 18, 21, 37-40, 44-47, 49, 53 and 54 which are generic or drawn to Species I as defined by the Examiner.

II. Applicants Traverse the Requirement

Insofar as Species I is concerned, it is believed that Species II, IV and V are so closely related to the elected Species that they should remain in the same application. The elected claims 1, 2, 7, 8, 10, 12-16, 18, 21, 37-40, 44-47, 49, 53 and 54 are directed to an optical pickup for a recording medium and claims 1, 2, 7-18, 21, 37-40, 41, 43-49 and 54 of Species II, IV and V are drawn to an optical pickup for a recording medium. Claim 1 is generic to at least Species I, II, IV and V. There have been no references cited to show any necessity for requiring restriction and, in fact, it is believed that the Examiner would find references containing claims of

the Species of optical pickups for recording mediums in the same field of technology.

On page 2 of the Office Action, the Examiner asserts that an election between Species I through VIII is required, but does not provide evidence as to why such a division need be made. Specifically, the Examiner has not provided evidence that the Examiner will experience an undue burden in searching and examining the invention set forth in Species I through VIII. Specifically, the Examiner has not provided evidence that the existence of the eight species represents an unreasonable number of species to be searched, and has not provided a rationale as to why the invention is to be separated into Species I through VIII. In contrast and consistent with the requirements in MPEP 803 and 808, the Examiner needs to provide a rationale as to why an election is required or how, without the election, the Examiner is unduly burdened in comparison with the burden visited on the applicants in the extra delay and expense in obtaining protection for each Species.

Further, there is no evidence on page 2 of the Office Action that the Examiner has considered the factors set forth in the guidance in MPEP 803. As such, it is respectfully submitted that the Examiner has not presented sufficient evidence of a burden on the Examiner in examining Species I through VIII which is out of proportion with the delay and expense visited on the applicants in protecting the invention of Species II through VIII so as to show an undue burden on the Examiner so as to also require an election between these Species.

MPEP §803 sets forth the criteria for restriction between patentably distinct inventions. (A) indicates that the inventions must be independent (see MPEP §802.01, §806.04, §808.01) or distinct as claimed (see MPEP §806.05-806.05(i)); and (B) indicates that there must be a serious burden on the Examiner if restriction is required (see MPEP §803.02, §806.04(a)- §806.04(i), §808.01(a) and §808.02). The Examiner has not set forth why there would be a serious burden if restriction is required.

Even if the Examiner considers Species I to be a separate invention from Species II through VIII, the Applicants respectfully request the Examiner to consider claims 1, 2, 7-18, 21, 37-40, 41, 43-49 and 54 of Species II, IV and V drawn to an optical pickup for a recording medium together with Species I. Applicants note that claim 1 is generic to at least Species I, II, IV and V.

III. Conclusion

Upon review of references involved in this field of technology, when considering that the

apparatus recited by the Species I claims as compared to the apparatus claims of Species II through VIII, and when all of the other various facts are taken into consideration, it is believed that upon reconsideration of the Examiner's initial election requirement, all of the pending claims should be examined in the subject application.

In view of the foregoing arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition for allowance.

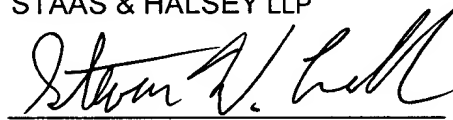
If any further fees are required in connection with the filing of this Amendment, please charge the same to our deposit account number 19-3935.

Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney.

Respectfully submitted,

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